

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NORIMASA NAGASAWA and NOBORU OBAYASHI

Appeal 2006-1453
Application 10/662,344
Technology Center 3600

Decided: February 27, 2007

Before, WILLIAM F. PATE, III, MURRIEL E. CRAWFORD, and ROBERT E. NAPPI, *Administrative Patent Judges*.

PATE, III, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the Examiner's refusal to allow claims 1-4, 6, 7, and 10-13. Claims 5, 8, and 9 have been canceled. These are all the claims that remain in the application.

The claimed invention is a hole plug for blocking the hole in an automotive body. The hole plug has a head portion having a back surface with a foot portion extending from the back surface. A column also projects

from the back of the head portion. A plurality of supporting means extends from the column to the foot portion.

Claim 1 reproduced below is further illustrative of the claimed subject matter:

1. A hole plug for blocking a hole, comprising:

 a head portion having a back surface,

 a foot portion extending from the back surface of the head portion to be inserted into the hole, said foot portion including a plurality of plate members extending from the back surface of the head portion and arranged circularly with a space between two of the plate members, each of said plate members having an engaging step portion at a base close to the head portion for engaging the hole,

 a column projecting from the back surface of the head portion inside the plate members, and

 a plurality of supporting means, each supporting means being disposed between the column and each of the plate members so that the column is connected to each of the plate members through each of the supporting means and the supporting means supports and suppresses the plate member from bending inwardly.

The references of record relied upon by the Examiner as evidence of anticipation and obviousness are:

Mejlso	US 3,181,411	May 4, 1965
Boik	US 4,504,009	Mar. 12, 1985
Kraus	US 4,761,319	Aug. 2, 1988
Jaeger	US 6,319,436 B1	Nov. 20, 2001

Claims 1-4 stand rejected under 35 U.S.C. § 102 as anticipated by Boik.

Claims 1, 2, and 12 stand rejected under 35 U.S.C. § 102 as anticipated by Kraus.

Claims 6 and 13 stand rejected under 35 U.S.C. § 103 as unpatentable over Boik in view of Mejlsø.

Claim 7 stands rejected under 35 U.S.C. § 103 as being unpatentable over Boik in view of Jaeger.

Claims 8-11 stand rejected under 35 U.S.C. § 103 as unpatentable over Boik in view of Mejlsø and Jaeger.

ISSUES

The sole issue on appeal is whether the Examiner has established that claims on appeal are anticipated or unpatentable over the prior art of record.

FINDINGS OF FACT

Boik discloses a hole plug or closure 22 with a head portion 24 and a foot portion 27. A pressure ring or wall 64, 68 forms a column projecting from the back surface of the head portion inside the circle of foot portions. In Figures 14 and 15, Boik shows backup lugs 75 and 77. We note that the backup lugs do not connect each of the plate members to the column as required by the claims on appeal.

Kraus discloses a closure cover with a head for a holding element 5 composed of spring arms 7. The spring arms 7 with catch member 6 correspond to Appellant's foot portions. Kraus also discloses a column 8'. See Figure 6. A supporting portion 9 extends from the backside of the foot portion 5, 7 but it does not connect the column 8' with the foot portion 5, 7.

Mejlsø has been cited by the Examiner as showing wavy-shaped support members. It is our further finding that Mejlsø discloses a hole plug with 2 foot portions 35, 39, a column projecting from the head 37, and a

wavy-shaped support means 36 and 38 connecting the column 37 to the foot portions 35 and 39.

Kraus is cited to show a hole plug for an automobile body having four guide elements or pilot members 60, 62, 64, and 66. The Examiner states that these are guide members as claimed in claim 7-11.

PRINCIPLES OF LAW

The prior art may anticipate a claimed invention, and thereby render it non-novel, either expressly or inherently. *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349, 64 USPQ2d 1202, 1206 (Fed. Cir. 2002), *cert. denied*, 538 U.S. 907 (2003). Express anticipation occurs when the prior art expressly discloses each limitation (i.e., each element) of a claim. *Id.* In addition, “[i]t is well settled that a prior art reference may anticipate when the claim limitations not expressly found in that reference are nonetheless inherent in it.” *Id.*

“A claimed invention is unpatentable if the differences between it and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the pertinent art.” *In re Kahn*, 441 F.3d 977, 985, 78 USPQ2d 1329, 1334-35 (Fed. Cir. 2006) citing 35 U.S.C. § 103(a) (2000); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14, 148 USPQ 459, 467 (1966). “The ultimate determination of whether an invention would have been obvious is a legal conclusion based on underlying findings of fact.” *Id.* (citing *In re Dembiczak*, 175 F.3d 994, 998, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999)).

In assessing whether subject matter would have been non-obvious under § 103, the Board follows the guidance of the Supreme Court in *Graham v. John Deere Co.* 383 U.S. at 17, 148 USPQ at 467. The Board

determines ““the scope and content of the prior art,”” ascertains ““the differences between the prior art and the claims at issue,”” and resolves ““the level of ordinary skill in the pertinent art.”” *Id.* (citing *Dann v. Johnston*, 425 U.S. 219, 226, 189 USPQ 257, 261 (1976)) (quoting *Graham*, 383 U.S. at 17, 148 USPQ at 467). “Against this background, the Board determines whether the subject matter would have been obvious to a person of ordinary skill in the art at the time of the asserted invention.” *Id.* (citing *Graham*, 383 U.S. at 17, 148 USPQ 467). In making this determination, the Board can assess evidence related to secondary indicia of non-obviousness like “commercial success, long felt but unsolved needs, failure of others, etc.” *Id.*, 383 at 17-18, 148 USPQ at 1335; *accord In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1455-56 (Fed. Cir. 1998). “We have explained that to reject claims in an application under section 103, an examiner must show an unrebutted *prima facie* case of obviousness. ‘On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.’” *Id.* (citing *Rouffet*, 149 F.3d at 1355, 47 USPQ2d at 1455).

ANALYSIS

As noted above in our findings of fact, we do not concur with the Examiner’s finding that Boik or Kraus shows foot portions that are connected to the column member with a plurality of supporting means as required by the claims on appeal. As we understand the Examiner, the Examiner states that the foot portions are connected to the column either because of their physical contact as shown in Figure 13 of Boik or that they are connected to the column portion through the agency of the head portion.

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Neither of the explanations is convincing in view of the claim limitation that the columns are connected to each of the plate members through each of the supporting means. For this reason the anticipation rejections on appeal are reversed. Furthermore, neither Mejlsø nor Jaeger can teach or suggest this feature. Therefore the obviousness rejections on appeal are also reversed.

OTHER ISSUES

Our findings of fact with regard to the Mejlsø reference are noted. In any further prosecution, the Examiner should make findings of fact as to whether the Mejlsø reference is anticipatory of any of the claims on appeal.

CONCLUSION

The Examiner has failed to establish that the cited prior art anticipates or renders obvious the claimed subject matter on appeal

The rejections of all claims on appeal are reversed.

REVERSED

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